

REMARKS

Reconsideration of the above-identified application as amended respectfully is solicited on behalf of the Applicants. With the instant response, one (1) claim, namely independent claim 15, has been amended in order to materially advance the status of the present prosecution. A clean copy of the amended claim is annexed hereto.

As a preliminary matter, it is noted that the Examiner has seen fit to make the instant Office action final. Under present practice, second actions on the merits shall not be made final where the examiner introduces a new ground of rejection not necessitated by amendment of the application by the applicant. M.P.E.P. § 706.07(a). The Examiner has indicated that the rejection of claims 15, 17-18, 23, and 24-27 constitutes a new ground of rejection. These claims, however, except to correct typographical errors, were not amended in Applicants' prior response. Accordingly, Applicants hereby respectfully request, pursuant to M.P.E.P. § 706.07(d), that the Examiner reconsider making final the instant Office action and to withdraw the same should it be found have been made prematurely. In any event, if the Examiner does continue to hold the rejection final, it is believed that the present remarks otherwise justify an allowance of the claims.

✓ Turning then to a consideration of the rejections of the Examiner, claims 15, 16, and 19-22 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kosuga *et al.*, U.S. Patent No. 4,960,642, for the reasons previously made of record in the Office action of November 30, 2001. Applicants submit that those claims should be considered allowable for the reasons made of record in the Amendment dated May 29, 2002.

Claims 15, 17-18, 23, and 24-27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Kosuga *et al.* reference in view of Kobayashi *et al.*, U.S. Patent No. 4,356,228. Applicants submit that these claims likewise should be considered allowable for the reasons made of record in connection with claims 15 and 24 in the Amendment dated May 29, 2002.

Further as to the Examiner's response to Applicants' arguments, Applicants had argued that the materials of Kosuga are different because they have a relatively higher degree of polymerization and, thus, a higher viscosity. The Examiner was not persuaded because Applicants do not claim the degree of polymerization. However, it is on the basis of the recited viscosity that Applicants consider the claims to distinguish over Kosuga. The degree of

polymerization was mentioned only to show how the claimed and the reference materials could have different viscosities even if the chemical constituents of those materials may be the same.

lack support

As to Applicants' argument that the viscosity of the claimed organic coating material is far outside the range of materials contemplated by Kosuga, the Examiner appears to be of the opinion that Kosuga reads on all materials having a viscosity of 10,000 cps or less. In this regard, independent claim 15 has been amended to recite that the claimed organic material has a viscosity at a temperature range of from 80-180°C of no greater than 1500 cps, and which material further is "selected to be impregnable into said core without substantial pressurization."

Doesn't matter
none

That is, and as mentioned at page 3, lines 19-23 of the specification as filed, "[a] major drawback to the method of Kosuga [sic] et al. is that the fibers must be impregnated under pressure."

doesn't say it
pressure

Thus, the Kosuga materials require the use of extruders or other high-pressure application to effect the impregnation of the fibers, whereas the instantly claimed materials may be

needed is
substantial or
where is

impregnated using a bath or other low pressure means. Indeed, the general disclosure of Kosuga

this
shown?
in
spec?

✓ notwithstanding, the reference does not appear to contemplate the selection of a coating material having a melt flow viscosity or other property which would allow it to be impregnated by a process, such as dip coating, which does not require the pressurization of the material.

since thing low pressure = pressure

As to the propriety of the amended claim language, "functional language does not, in and of itself, render a claim improper." M.P.E.P. 2173.05(g), citing *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). For example, it has been held that the limitation used to define a radical on a chemical compound as "incapable of forming a dye with said oxidizing developing agent" although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. *Id.*, citing *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971).

met Lastly, as to Applicants' argument that the resins listed in Kobayashi reference appear to be used as the matrix resin rather than, as is claimed, as a coating which is applied to the fibers, the Examiner has responded that "Kosuga and Kobayshi are used in combination to show that the resins are functional equivalents and can be substituted for one another." However, it is well-settled that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting the combination. *In re Geiger*, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987), citing *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1987), See also *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383

(Fed.Cir.1997) (noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”). The Federal Circuit has cautioned that the suggestion to combine requirement is a safeguard against the use of hindsight combinations to negate patentability. See *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998).

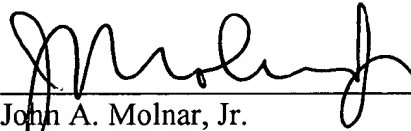
Applicants are mindful that evidence of a suggestion, teaching, or motivation to combine prior art references may be found not just in the references themselves, but also in the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved, although “the suggestion more often comes from the teachings of the pertinent references.” *In re Dembiczak*, 175 F.3d at 994, 999 (Fed. Cir. 1999), citing *Rouffet*, 149 F.3d at 1355. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the reason to combine must nevertheless be “clear and particular.” *Winner Intern. Royalty Corp. v. Wang*, 202 F.3d 1340, 1348-49 (Fed. Cir. 2000), citing *Dembiczak*, 175 F.3d at 999. “Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.’ ” *Dembiczak*, 175 F.3d at 999, quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983).

Applicants have endeavored to point out that the resins listed in the Kobayashi reference appear to be used as the matrix resin rather than, as is claimed, as a coating which is applied to the fibers and which coated fibers, in turn, are encased in a matrix resin to form a pellet. On this basis, Applicants submitted that one of ordinary skill in the art, following the teachings of the Kobayashi reference, would not have been motivated to substitute those resins, which in fact appear to be true polymers rather than monomers or oligomers, for the oligomer resins coating materials of the Kosuga reference. The Examiner, in turn, seems merely to assume that it is always obvious to interchange materials that may be known in the art. Such an assumption would appear to bespeak of the impermissible use of hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Accordingly, Applicants submit that even if the combination proposed by the Examiner would have been sufficient to render the claimed invention obvious, there has yet to be articulated a suggestion or other motivation in the prior art

or otherwise which would have lead one of ordinary skill in the art to have combined the cited references in the manner proposed.

In view of the foregoing, the issuance of a Notice of Allowance is earnestly solicited. If an allowance of the claims is not forthcoming, please enter this amendment for purposes of appeal.

Respectfully submitted,



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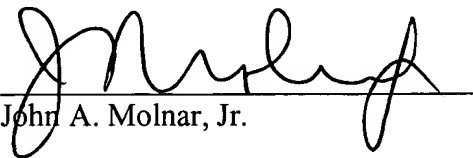
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited on November 25, with the United Postal Service as first class mail in an envelope addressed to: BOX AF, Commissioner for Patents, Washington, D.C. 20231.



John A. Molnar, Jr.

AMENDED CLAIM

Claim 15 has been amended as follows:

15. (Amended) A plurality of pellets capable of being consolidated into an electrically shielded composite wherein said pellets comprise a core of conductive fibers; wherein said core has a coating comprising an organic material having a viscosity at a temperature range of from 80° C - 180° C no greater than 1500 cps and being selected to be
- 5 impregnable into said core without substantial pressurization; and wherein said core and said coating are encased by a polymer.